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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,210	06/11/2001	Joji Onishi	109748	9564
25944	7590	07/15/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			QIN, YIXING	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/877,210	Applicant(s) ONISHI ET AL.	
	Examiner Yixing Qin	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 October 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                              |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/22/05</u> . | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Amendment***

No amendment was made.

### ***Response to Arguments***

In response to the remarks made, the Examiner agrees with the Attorney that the two DeBry references did not disclose the Applicant's invention, as was discussed in the interview. However, new art has been found to teach and/or suggest the authentication of print data. Please see the new rejection below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims 1, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nosaki et al (U.S. Patent No. 5,673,373).

#### **1. Claims 1, 7 and 9**

Nosaki discloses in :

- Fig. 4 their system for printing a secure document.
- Column 5, lines 49-51 that the print command data (1) is queued and stored in the HDD on the file server. Although not explicitly stated, the registration request

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would essentially be the process of giving a command to print an item and sending the print command data to the file server – knowing that this information would be stored and processed before printing (i.e. **registered**).

- One can see in Fig. 4 that print information can be relayed from the file server to the printer or the terminal through a network (see also Fig. 1). There would inherently be some **providing device** such as a network card to provide the information to other entities on the network.
- Column 6, lines 8-23 the process of obtaining a password from a print server and the sending of this password along with other pertinent information (see item (4) in Fig. 4) back to the file server. One can see that the various print information are associated with the password (**authentication information**).
- Fig. 4 item (5) information (i.e. **usage certificate information**) sent back to the terminal from the file server.
- Column 6, lines 32-47 the process of relaying a password to a user and the user using this password to obtain a print of his own job. This job could be provided from the file server.

II. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nosaki et al (U.S. Patent No. 5,673,373). In view of Miura (U.S. Patent No. 6,862,103)

## 2. Claim 2 and 10

Nosaki does not explicitly disclose the use of an usage count. However, the secondary reference, Miura, discloses

- in Fig. 47 and column 35, lines 25-32 the idea of using a count to allow certain documents to be printed only a certain number of times. A denied print request can indicate that the providing means never transmits the print data to be printed.
- Both references are in the art of printing in a networked environment with authentication capabilities. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to improve Nosaki's invention with a usage counter.

III. Claims 3-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nosaki et al (U.S. Patent No. 5,673,373) in view of DeBry (U.S. Patent No. 6,314,521).

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### 3. Claim 3

For the following claims, please also note the rejection to these claims from the previous Office Action. Although the previously used DeBry references did not focus primarily on print data, they disclose the concept of the relaying of information based upon IP addresses. Both Nosaki and DeBry are in the art of authentication and printing. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the relaying of information based upon network/IP addresses disclosed in DeBry and apply them to relaying a different kind of information, i.e. print data.

Nosaki discloses :

- in Fig. 11, 4<sup>th</sup> item from the top, a step of sending information to a designated printer. Also note in column 5, lines 45-46 that the print command data (1) has information of the designation of the file server (i.e. would be obvious to use a **network address**). Networked apparatuses are well-known to be identified by network addresses and it would be an obvious feature to include in a usage certificate data, since it would enable identification of where the print data is to be provided to.

### 4. Claims 4 and 8

- This is analyzed in similar fashion as claim 3 above. The data usage request could simply be a print command to print the print data from the terminal 1 in Fig. 4. It would be an obvious feature to include network addresses to identify this terminal so programs on the network can properly relay information.

### 5. Claim 5

- Again, from claims 3 and 4 above, the use of network addresses would be a clear advantage to include in various certificates since the network needs to know where to route information. Column 6, lines 4-8 discloses the assignment of the print server as a destination and the file server as a sender. It would be obvious to identify the destination and sender with a network address. It is not explicitly stated what happens if a network address is not included.

The DeBry reference discloses :

- In column 9, lines 6-9 that "[t]he certificate authority 50 then checks to see if the IP address...found in the encrypted part of the message matches the IP address

the message was sent from." This indicates that the certificate authority knows where the message is coming from. Even if no IP address was specified, it would have been obvious to one of ordinary skill that a printer requesting a certificate would be the one that the server should send the certificate back to.

- Both the Nosaki and DeBry references disclose the relaying of information relating to authentication in a network environment. Therefore, it would have been obvious to one of ordinary skill in the art that the network address of incoming request would be the only address known and thus would make the sender of the request the only logical choice to return a message to. The motivation would be so that less data would be needed if it can be assumed where a response was supposed to be relayed to.

## **6. Claim 6**

- This claim is similarly analyzed as claim 5 above. The only difference is to put the network address in the data usage request as opposed to the data registration request.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381.


The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YQ

  
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